

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Spall et al.	Art Unit	: 1797
Serial No.	: 10/628,072	Examiner	: Keri A. Moss
Filed	: July 25, 2003	Conf. No.	: 3044
Title	: COMBINATION MARKER FOR LIQUIDS AND METHOD IDENTIFICATION THEREOF		

**Mail Stop Amendment**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 12-19, 21-25, 51-57, and 59-61 are pending, with claims 12, 23, 51, and 61 being independent. Claims 12-19, 21-25, and 56 are allowed. Claims 51-54 and 59-61 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Meyer* (U.S. Patent No. 6,312,958) in view of *Anderson '937* (U.S. Patent No. 5,474,937). Claim 55 is rejected under 35 U.S.C. 103(a) as unpatentable over *Meyer* in view of *Anderson '937* and further in view of *Atkinson* (U.S. Patent No. 3,746,634). Claim 57 is rejected under 35 U.S.C. 103(a) as unpatentable over *Meyer* in view of *Anderson '937* and further in view of *Atkinson* (U.S. Patent No. 3,746,634) and *Anderson '283* (U.S. Patent No. 5,981,283).

Applicant specifically asks the panel to review the issues highlighted below.

**1. There is no suggestion or motivation to combine *Meyer* and *Anderson* '937.**

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The Office Action states: "[m]arkers that fit within the desired range of Meyer, meaning within 600-1200 nm include alcohols such as ethanol or methanol; ethers such as dioxane; ketones such as acetone; and aliphatic or aromatic hydrocarbons such as octane, xylene (column 14 lines 55-67)." Office Action, at 3. Thus, despite the fact that *Meyer* "relates to a method of marking liquids using at least two markers, wherein said markers absorb in the 600-1200 nm region of the spectrum and reemit fluorescent light and the absorption range of at least one marker overlaps with the absorption range of at least one other marker." the Examiner has, without basis, instead redefined the markable liquid of Meyer as a "second marker." The Examiner's "second marker," however, is not consistent with *Meyer*'s description of a marker. Furthermore, the Examiner has not explained how alcohols, ethers, ketones, and aliphatic or aromatic hydrocarbons such as octane, xylene, etc., satisfy the marker criteria of *Meyer*. See pp. 8-9 of Amendment Under 37 C.F.R. § 1.11 filed on June 27, 2008 ("the Amendment").

The Office Action then states: "it would have been obvious for one of ordinary skill in the art to modify the reference of Meyer by deuterating at least one of the markers made up of the disclosed markers that can be produced with stable isotopes not generally found in nature in order to gain the advantages of readily available and easy to make markers that are more environmentally friendly." Office Action, at 4. However, the Examiner has failed to address the fact that the markers of *Anderson* '937 do not possess the basic properties of the markers required by *Meyer*. See the Amendment, pp. 9-10. As such, the Examiner has failed to consider *Meyer* in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

**2. There is no reasonable expectation of success.**

Labeling a markable liquid of *Meyer* for use instead as the second marker in *Meyer* provides no reasonable expectation of success, and would render *Meyer* unsatisfactory for its intended purpose, at least because the markable liquids of *Meyer* do not satisfy *Meyer*'s criteria for a second marker. Such a modification can only be explained as a result of hindsight reasoning. Hindsight analysis of the prior art and picking and choosing aspects of references based on Applicants' Application is an improper analysis for asserting an obviousness rejection. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. at 1742-43. "It is well settled that the claims cannot be used in hindsight as a template to reconstruct the invention willy-nilly by picking and choosing elements at will from prior art." *Procter & Gamble Co. v. Paragon Trade Brands, Inc.*, 989 F. Supp. 547, 587 (D. Del. 1997); *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

**3. All the claimed elements are not taught or suggested.**

Claim 55 recites in part: "wherein the second marker is a polynuclear aromatic hydrocarbon." *Atkinson*, however, teaches saturated deuterated hydrocarbons. Thus, the deuterated compounds of *Atkinson* cannot be aromatic. See the Amendment, p. 11.

Claim 57 lists unsaturated aromatic compounds. As such, the combination of the cited art does not teach or suggest an aromatic molecular marker that is artificially enhanced with a non-radioactive isotope. See the Amendment, p. 12.

The Examiner contends: "the compounds of *Atkinson* and of the instantly claimed invention are the same.... Both are deuterated polynuclear aromatic hydrocarbons." Office Action, at 6. This is clearly not the case. The deuterated compounds of *Atkinson* are cyclic, but not aromatic.

Thus, for at least the above reasons, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal the § 103(a) rejections of Claims 51-55, 57, and 59-61.

Applicant : Spall et al.  
Serial No. : 10/628,072  
Filed : July 25, 2003  
Page : 4 of 4


Attorney's Docket No.: 21546-0022001

Applicant submits that all claims are in condition for allowance.

Please apply any charges, or any credits, to deposit account no. 06-1050, referencing Attorney Docket No. 21546-0022001.

Respectfully submitted.

Date November 17, 2008

  
Heather L. Flanagan, Ph.D.  
Reg. No. 54,101

Fish & Richardson P.C.  
One Congress Plaza, Suite 810  
111 Congress Avenue  
Austin, TX 78701  
Telephone: (512) 226-8148  
Facsimile: (512) 320-8935